

### **REMARKS**

Applicants thank the Examiner for the very thorough consideration given the present application. In view of the above amendment, Applicants believe the pending application is in condition for allowance.

Claims 1-6 and 8-15 are now present in this application. Claims 1 and 11 are independent. Claim 7 has been cancelled, claims 11-15 have been added, and claim 1 has been amended. Reconsideration of this application, as amended, is respectfully requested.

#### **Information Disclosure Citation**

Applicants filed an Information Disclosure Statement on October 30, 2007, and respectfully request an initialed copy of the PTO-1449 or PTO-SB08 form.

#### **Specification Objection**

The Office Action has objected to the Specification because of minor informalities. In order to overcome this objection, Applicants have amended the Specification to correct the deficiencies pointed out by the Examiner. Reconsideration and withdrawal of this objection are respectfully requested.

#### **Claim Objections**

The Office Action has objected to claim 1 because of minor informalities. Applicants have amended claim 1 to correct the noted deficiencies. Reconsideration and withdrawal of this objection are respectfully requested.

#### **Obviousness-Type Double Patenting Rejection**

Claims 1-10 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 3-11 of a copending U.S. Patent Application No. 10/539,310. Applicants will address this provisional rejection when allowable subject matter is indicated.

**Rejections under 35 U.S.C. § 103**

Claims 1-5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Song et al. (hereinafter Song '842) in view of Morita et al. Claims 6 and 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the references as applied to claim 1 and further in view of Chevron 600R. Claim 1 has been amended to include subject matter similar to that as recited in dependent claim 7. Accordingly, comments will be presented distinguishing claim 1 over the rejection of claim 7 under 35 U.S.C. § 103(a).

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

Amended independent claim 1 includes a combination of elements and is directed to a reciprocating compressor for compressing a refrigerant including a hermetic container to which a suction pipe and a discharge pipe are connected, a driving unit having a stator fixed inside the hermetic container and a mover disposed apart from the stator and linearly and reciprocally moved according to an interaction with the stator, an organic compound refrigerant sucked into the suction pipe, having combustibility and explosiveness and including only carbon and hydrogen, a compression unit for receiving a reciprocal motional force of the driving unit and making a compression operation on the organic compound refrigerant, a mineral-based lubricant filled at a lower portion of the hermetic container, and a lubrication unit for supplying the mineral-based lubricant to each motional portion of the driving unit and the compression unit and performing a lubricating operation. As discussed above, independent claim 1 has been amended to include the subject matter similar to that as recited in dependent claim 7. In particular, amended independent claim 1 recites that the mineral-based lubricant has a density of  $0.866\sim 0.880\text{ g/cm}^3$  at a temperature of  $15\text{ }^{\circ}\text{C}$  and a flash point of above  $140\text{ }^{\circ}\text{C}$  such that the mineral-based lubricant mixes with the organic compound refrigerant to perform the lubricating operation.

These features are supported at least by FIG. 1 of the present application. For example, the reciprocating compressor includes a hermetic container 6 to which a suction pipe 2 and a discharge pipe 4 are connected, a driving unit 8 having a stator fixed inside the hermetic container 6 and a mover disposed apart from the stator and linearly and reciprocally moved

according to an interaction with the stator, an organic compound refrigerant sucked into the suction pipe 2, a compression unit 10 for receiving a reciprocal motional force of the driving unit 8 and making a compression operation on the organic compound refrigerant, a mineral-based lubricant filled at a lower portion of the hermetic container 6, and a lubrication unit 12 for supplying the mineral-based lubricant to each motional portion of the driving unit 8 and the compression unit 10 and performing a lubricating operation. Further, the Specification lists the preferred conditions for the mineral oil to have a "favorable compatibility with hydrocarbon" of the organic compound refrigerant, and to satisfy "physical and chemical characteristics." (see page 10, lines 6-22 of the Specification)

Therefore, specific advantages are achieved with the claimed range. That is, as discussed in the Specification at page 2, lines 18-22, it is difficult to use a mineral-based lubricant with an organic compound. The present invention solves these problems by selecting the specific density range and the flash point of the mineral-based lubricant.

On the contrary, Song '842 in view of Morita et al. does not teach or suggest these features of the invention. Further, although the Office Action states that Chevron 600R teaches the conditions recited in previously presented claim 7 (see page 9 of the Office Action) and provides "superior cold-flow performance", Chevron 600R does not teach or suggest that such conditions allow the mineral-based lubricant to mix with the organic compound refrigerant to perform the lubricating operation. Therefore, there is no motivation to combine the Chevron 600R reference and the references as applied in rejection of claim 1.

In addition, it appears that the Office Action combines bits and pieces from the three references together in an attempt to create a combination and method similar to that defined by the claim 7 of the present application. Thus, through a process of impermissible hindsight reconstruction, it appears that the Office Action reconstructs the teachings of the references in view of the Applicants' own disclosure. *See, Grain Processing Corp. v. American Maize-Products Co.*, 840 F.2d 902, 907, 1792 (Fed. Cir. 1988) (stating "Care must be taken to avoid hindsight reconstruction by using 'the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit'"). Further, as recently followed in *Alza Corp.*, the Federal Circuit has consistently

held that an Examiner cannot use the claim of the Applicant "as a template . . . selecting elements from references to fill the gaps." *Alza Corp. v. Mylan Pharma., Inc.*, 8 U.S.P.Q.2d 1001 (Fed. Cir. 2006). Such is the case here where the Examiner must rely on no less than three different references, each aimed at solving different problems than that which claim 7 is directed at addressing.

Accordingly, it is respectfully submitted that amended independent claim 1 and each of the claims depending therefrom are allowable.

Further, it is respectfully submitted the other 35 U.S.C. § 103(a) rejections have also been overcome as the claims rejected therein are dependent claims and the additional applied references also do not teach or suggest the features recited in the independent claim.

#### **Claims Added**

Claims 11-15 have been added for the Examiner's consideration. In particular, new independent claim 11 recites similar features to the previous presented claim 1 and dependent claim 8, and clarifies that the lubricant has a kinematic viscosity of 7.2~21.8 mm<sup>2</sup>/s at a temperature of 40 °C and a viscosity index of 73~99 such that the mineral-based lubricant mixes with the organic compound refrigerant to perform the lubricating operation. It is respectfully submitted the applied art also does not teach or suggest these features.

#### **CONCLUSION**

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

Application No. 10/539,301  
Amendment dated: January 7, 2008  
Reply to Office Action of October 5, 2007

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If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Jun S. Ha, Registration No. 58,508, at (703) 205-8000, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: January 7, 2008

Respectfully submitted,

By 

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